Remarks

Claims 1 and 3-9, as amended, and new claims 10-15 are pending in the application. Claim 2 is canceled without prejudice as the limitations of claim 2 have been incorporated in amended claim 1. Support for the amendments and new claims are found in the specification and present no new matter. For example, support for the amendments to claim 1 and new claims 10-15 may be found in the specification on page 219, line 25 to page 220, line 21.

Claims 1-6 stand rejected under 35 U.S.C. 102(e) and 35 U.S.C. 102(f) as being anticipated over Kauffman et al., US 6,329,342 ("Kaufmann"). The Office alleges that numerous examples contained within Kaufmann anticipate the claims of the present invention. The Office further alleges that since the inventorship in Kaufmann and the present application are different, a rejection under 35 U.S.C. 102(f) is appropriate.

Without acquiescing to the rejection, the rejection is deemed to be moot regarding now-canceled claim 2. Regarding the remaining claims, applicants have amended the claims to excise subject matter that was disclosed in Kaufmann. The claims as they presently stand contain subject matter disclosed for the first time in the present application and are therefore novel. For example, there is no corresponding disclosure in Kaufmann that teaches the subject matter found in amended claim 1 and new claims 10-15 as supported in the specification on page 219, line 25 to page 220, line 21 of the present application. Further, the scope of the claims in the present application have been clearly demarcated from Kaufmann to reflect the proper inventive entitites. The inventors of the present application, Dodge and Lugar, are the co-inventors of the limited subject matter contained herein. Therefore, applicants respectfully request reconsideration and withdrawal of the rejection of the pending claims under 35 U.S.C 102(e) and (f).

On a related note, even though the present claims are not rejected for obviousness, Kaufmann cannot render obvious the claimed invention as specified under 35 U.S.C. 103(c) since Kaufmann only qualifies as prior art under 35 U.S.C. 102 (e) or (f) as applied by the Examiner and the inventions were owned by the same person (Eli Lilly and Companay) at the time the inventions were made.

Claims 1-9 stand rejected under 35 U.S.C. 102(a) as being anticipated by WO 99/08699. The Office alleges that numerous examples contained within Kaufmann anticipate the claims of the present invention. The Office further alleges that since the inventorship in Kaufmann and the present application are different, a rejection under 35 U.S.C. 102(f) is appropriate.

Without acquiescing to the rejection, the rejection is deemed to be moot regarding now-canceled claim 2. Regarding the remaining claims, applicants point out that the priority date of the instant case (19 February 1999) pre-dates the publication date of WO 99/08699 (25 February 1999), so claimed invention was not "...patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a

patent." Further, applicants have amended the claims to excise subject matter that was disclosed in WO 99/08699. The claims as they presently stand contain subject matter disclosed for the first time in the present application and therefore could not have been "...known or used by others in this country." For example, there is no corresponding disclosure in WO 99/08699 that teaches the subject matter found in amended claim 1 and new claims 10-15 as supported in the specification on page 219, line 25 to page 220, line 21 of the present application. Further, the scope of the claims in the present application have been clearly demarcated from WO 99/08699 to reflect the proper inventive entitites. The inventors of the present application, Dodge and Lugar, are the co-inventors of the limited subject matter contained herein. Therefore, applicants respectfully request reconsideration and withdrawal of the rejection of the pending claims under 35 U.S.C 102(a) and (f).

Claims 1-9 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of the co-pending Application Number corresponding to the national stage of WO 99/08699. Applicants point out that the national stage filing of WO 99/08699, U.S. Pat. Appln. No. 09/486,019, has been abandoned and cannot mature into a U.S. patent. However, a related patent, U.S. 6,639,076, claiming priorities including WO 99/08699 has issued. It arose from the national stage filing of WO 00/10565, cited herein in the enclosed Information Disclosure Statement. While said patent is not an application arising out of the national stage filing of WO 99/08699, it does claim priority from WO 99/08699. Without acquiescing to the rejection, applicants provide a terminal disclaimer over US 6,639,076.

Applicants respectfully request reconsideration and withdrawal of the pending rejections. A favorable notice to that effect is earnestly solicited.

Respectfully submitted,

William R. Boudreaux
Attorney/Agent for Applicants
Registration No. 35,796
Phone: 317-276-0755

Eli Lilly and Company
Patent Division/WRB
P.O. Box 6288
Indianapolis, Indiana 46206-6288

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